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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,425	08/03/2001	Gary Mittman	R258-DB	7477

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EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,425

Applicant(s)

MITTMAN ET AL.

Examiner

Yehdega Retta

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Wii

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/24/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

This office action is responsive to amendment filed May 24, 2004.

Response to Arguments

Applicant's arguments filed May 24, 2004 have been fully considered but they are not persuasive.

Applicant argument to the combination or motivation to combine of the prior art is noted. However the court ruled as follows in regard to obviousness and motivation to combine.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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Applicant argues that the Benson system deals exclusively with a telecommunication environment and the instant invention being carried over the Internet. Further applicant states that the Benson system being limited in scope since the Benson system provides no way for media buyer of the system to measure the effectiveness of advertising media purchase in any environment other than through a PSTN. That is correct however Benson teaches how to measure the effectiveness of media purchase by providing information that leads customer to the point of sale, by providing an 800 number and tracking the activity. Examiner took official notice that it would have been obvious to one of ordinary skill in the art to replace the 800 number by URL in order to lead customer to the point of sale, which is the web site. Further Examiner stated that it would have been obvious to determine the geographic location associated with the Internet protocol address which is analogous to Benson's determination of geographic location by cross-referencing caller's number and zip-code.

The following prior art are provided to support the official notice taken by the Examiner.

a) "Intel's Pentium II gets \$20 mil intro"; (Intel launching Pentium II microprocessor worldwide on 5/7/97, backed by a \$20 mil ad campaign), "Chip maker will use Web sites to test response to online, print ads" which teaches including a web address on printed media and banner ads and measuring each medium's effectiveness in driving traffic to the site.

b) "Draft helps put stamp of approval on campaign"; (Stamps.com launches a new advertising campaign that includes a direct mail piece and a direct response TV spot), which teaches including unique URL on TV promotion which allow tracking of response to the TV promotion.

c) "Marketing communication and the word wide web". (Opportunities of internet marketing described), which teaches well-known awareness generating techniques that includes placing the web site address in all advertising to generate a flow of surfers to the web site and calculating the awareness efficiency.

d) Gardner SR., US Pub. No. 2003/0023511 A1, which teaches tracking online activity to the advertising source which initially led a consumer to a given web address.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson U.S. Patent No. 6,470,079 and further in view of Cope U.S. Application Publication No. 2002/0046281.

Regarding claims 1-8, Benson teaches advertising media purchase placed in either of movies, video, television, print, etc. within stated geographic area, tracking goals achieved, correlating and reporting the times of the goals achieved by customer... Benson teaches each media purchase including a unique directory number for accessing further information related to the subject matter of the media purchase. Benson teaches a database containing records correlating user geographic information, by cross-referencing caller's number and zip-code (see col. 5 line 18 to col. 7 line 10 and col. 9 line 55 to col. 10 line 32). Benson teaches all claimed

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features except for the media purchase including a web address and correlating user protocol address to the geographic area and tracking the Internet related goals. Official Notice is taken that providing a web address on media purchase is old and well known in the art of marketing. One would be motivated to provide a web address on media purchase, instead of "800", in order to direct the user to the point of sale (web site). Official Notice is taken that determining geographic location associated with an Internet Protocol address is old and well known in the art of WWW. One would be motivated to determine the geographic location of users in order to report demographic information of the respondents to the campaign, as taught by Benson. Cope teaches tracking web related goals and correlating and reporting the timing of Internet related goals (see page 2 par. 29 to page 5 par. 73). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Benson's reporting of advertising campaign with Cope's tracking of Internet related goals in order to evaluate the advertising effectiveness of the purchase media, as taught by Benson (see col. 1 line 65 to col. 2 line 55).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yehdega Retta
Primary Examiner
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